

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 12, 2004. Through this response, claims 30, 40, 42, 43, and 45 have been amended. Reconsideration and allowance of the application and pending claims 1-48 are respectfully requested.

I. Abstract Objection

The abstract of the disclosure has been objected to because the Abstract is over 150 words. Through this Response, Applicants have revised the Abstract to have a word count less than 150 words. In view of that amendment, Applicants respectfully request that the objection be withdrawn.

II. Claim Rejections – 35 U.S.C. §101

Claims 30-38, 40-43 and 45-48 have been rejected under 35 U.S.C. §101, because said claims are allegedly directed to non-statutory subject matter. The Office Action states that, “as per claims 30-38, 40-43 & 45-48, as drafted said claims are not limited by language within the technological arts.” Applicants have amended the preamble and body of independent claims 30 and 40 (and dependent claims 42, 43, and 45) to clarify that, in one embodiment, a content packet is prepared by a computer-based device, such as a server. In that those objections are believed to have been overcome, Applicants respectfully request that the rejection of these claims under 35 U.S.C. § 101 be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 1-48 have been rejected under 35 U.S.C. § 103(a) as allegedly being anticipated by *Marks* ("Marks," U.S. Pat. Application No. 2001/0034651). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (USPTO) has the burden under section 103 to establish a prima facie case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead the individual to the claimed invention. See *In re Fine*, 837 F.2d, 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a prima facie case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such prima facie case has been made in the outstanding Office Action.

Independent Claim 1

As recited independent claim 1, Applicants claim (with emphasis added):

1. A server from which a sender distributes content messages to one or more receivers, comprising:
a processor;
memory;
a content packet stored in the memory, the content packet including:
message content;
a sender bank identifier; and
a value that indicates an amount that the sender offers to credit a receiver for rendering at least a portion of the message content.

Applicants respectfully submit that *Marks* fails to disclose, teach, or suggest at least the emphasized features. The system in *Marks* discloses that ads are sent, but not in the form of a

content packet with the structure described in independent claim 1. For example, as acknowledged by the Office Action, “Marks lacks explicit recitation of ‘a sender bank identifier.’” Applicants agree with this assertion. However, the Office Action alleges that *Marks* (in paragraph 0049) implicitly shows a “sender bank identifier,” and further alleges that “it would have been obvious to modify and interpret the disclosure of Marks cited above as implicitly showing those elements and limitations not explicitly recited, because modification and interpretation of the cited disclosure of Marks would have provided means for ‘immediate or near gratification for responding to Internet advertising.’” Applicants disagree with this assertion.

As stated in MPEP 2112, “in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” The Office Action alleges as support for the obviousness assertion paragraph [0049], which provides in part as follows (emphasis added):

[0049] The benefit program of the present invention may be also used for Internet merchants. If a customer logs on to a merchant's web site, he will be identifiable to the merchant. If the customer is an unknown visitor he could have an identifier or cookie sent to his web browser when he visits the merchant. The customer may ultimately be identified to the merchant if he makes a purchase. However, using the present invention, the benefit provider and advertiser do not need to know anything about the customer. Any participating ads that are viewed while at the merchant's site may be credited toward purchases from the host merchant.

In other words, *Marks* provides a system that provides compensation “in the form of an immediate discount towards goods and/or services at the host merchant.” (see Abstract) In such an operation, it does not necessarily flow that a *sender bank identifier* is needed or sent, since the immediate gratification is in the form of a discount provided by the merchant, which would not necessarily require the *sender bank identifier*.

As another example of missing claim features, *Marks* does not disclose a ***content packet*** that includes *a value that indicates an amount that the sender offers to credit a receiver for rendering at least a portion of the message content*. For example, in paragraph [0017] cited by the Office Action, the specification states as follows (with emphasis added):

[0017] A business or web site that provides space or time for advertising is a "host location" or "host." A consumer or customer is credited with a benefit if he acts upon an ad at the host location. In acting upon an ad the consumer performs an action to verify that he has seen (or heard), or had time to see (or hear), an ad. This is considered an ad "response" or "view." In the preferred embodiment the consumer must make a purchase from the host location to actually receive the benefit. The host whom the consumer is currently visiting pays the benefit by way of a discount, premium or upgrade to the consumer. The incentive program provider and/or the advertiser or advertisement provider then reimburses the host. Alternatively, the host may act as the incentive program provider and supply benefits without reimbursement.

In other words, assuming a value was transferred to the host location (*e.g.*, a discount rate, *etc.*), this section describes that it is through the purchasing of merchandise that a consumer achieves a benefit, and thus any value delivered to the host would likely include ***an amount*** that the sender offers to credit a receiver for purchasing product corresponding to the ad, not for ***rendering at least a portion of the message content***.

The Office Action provides that FIG. 1, and paragraphs [0017], [0018], [0028], [0029], [0031], [0035], [0040], [0042], [0047], [0049], and [0052] "implicitly shows all the elements and limitations of claim 1." As explained above, saying there is an implicit disclosure means the claimed features necessarily flow from the cited paragraphs. Applicants respectfully disagree that these paragraphs provide an implicit disclosure of the emphasized features. Paragraph [0017] has been discussed above. As another example, consider paragraph [0018], which provides that under "one embodiment of the present invention, the benefits may be used immediately." As already explained, an immediate benefit disclosed in *Marks* is a discount on a purchased product, and thus an implicit disclosure does not necessarily follow. As another example, paragraph [0028] provides that participating "ads

may include a digital identifier that may signify participation in the program to the host computer.” The fact that a digital identifier may be included does not disclose or suggest that a *content packet* with the claimed features is delivered, since a digital identifier can be provides using other means, such as a watermark.

Likewise, not only are the other paragraphs simply not showing the emphasized features, but an implicit disclosure of those features does not necessarily follow. For example, with regard to paragraph [0029], the description provides as follows:

If a consumer responds to an advertisement at a given terminal, the terminal may notify a computer at the host. Responding to an ad may mean clicking on a banner or page to see more detailed information from the advertiser. The host may know that an advertisement is participating in the benefit program by recognizing a digital identifier that is sent to the host when a consumer responds to an ad at the given terminal; alternatively the host may recognize that an ad is participating in the benefit program when it delivers the ad to the prospective consumer’s terminal. Recognizing the digital identifier, the host may know the specified benefit (discount or premium) to be awarded to the given terminal.

Nothing in this cited section discloses, teaches, or suggests a *content packet* that provides a *value that indicates an amount that the sender offers to credit a receiver for rendering at least a portion of the message content*. Assuming some value is sent, it would be the value of a discount or rebate corresponding to a purchase, and not an amount that credits a receiver for rendering the message. The same paragraph provides the “incentive program of the present invention is response based and may work in parallel with other advertising programs that may be billed on different bases such as page views or pay responses.” Applicants respectfully submit that this paragraph does not disclose, teach, or suggest a credit *for rendering at least a portion of the message content*.

Paragraphs [0031, [0035], [0040], [0042], [0047], [0049], and [0052], cited in the Office Action, also do not disclose, teach, or suggest the emphasized features for similar reasons as provided above.

Because independent claim 1 is allowable over *Marks*, dependent claims 2-12 are allowable as a matter of law for at least the reason that the dependent claims 2-12 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Further, Applicants respectfully traverse the finding of Official Notice as to claims 2-12. For example, nothing in *Marks* discloses, teaches, or suggests a *content message* wherein *the value is a first value that indicates an amount that the sender offers to credit a receiver for rendering the message content on a display* and wherein *the content packet further comprises a second value that indicates an amount that the sender offers to credit a receiver for printing the message content*, as recited in claim 3. That immediate gratification can be achieved through discounts or rebates of purchased products, as disclosed in *Marks*, does not necessarily flow through the mechanisms described in claims 1-12. Thus, the emphasized claim features don't implicitly follow from the teachings of *Marks* in light of the knowledge of those having ordinary skill in the art, and no evidence has been proffered to support the assertion of Official Notice. Thus, Applicants respectfully request that the rejection to claims 1-12 and the Official Notice be withdrawn.

Independent Claim 13

As recited independent claim 13, Applicants claim (with emphasis added):

13. An e-mail program stored on one or more computer readable media, comprising:

a receiver module configured to receive a content packet from one or more senders, the content packet including a content message, an advertiser bank account identifier, a value that the sender is willing to pay to render the content message, and finishing instructions detailing how the content message is to be rendered;

a bank request module configured to verify that an advertiser bank account identified by the advertiser bank account identifier in the content packet can satisfy the value identified in the content packet;

a rules module containing payments required to render the content message;

a rendering module configured to render the content message if the value meets or exceeds a value established in the rules module and if the bank request

module verifies sufficient funds in the advertiser bank account to pay the value included in the content packet; and
a certification module configured to confirm that the content message has been rendered and to send a certification to the advertiser bank that the content message has been rendered.

Applicants respectfully submit that *Marks* fails to disclose, teach, or suggest the emphasized features. The system in *Marks* discloses that ads are sent and received, but not in the form of a ***content packet*** with the structure described in independent claim 13. Further, *Marks* discloses a system that provides compensation “in the form of an immediate discount towards goods and/or services at the host merchant.” (see Abstract) In such an operation, it does not necessarily flow that ***advertiser bank identifier*** is needed or sent, since the immediate gratification is in the form of a discount provided by the merchant, which would not necessarily require the ***advertiser bank identifier***.

Marks also does not disclose a ***content packet*** that includes ***a value that the sender is willing to pay to render the content message***. From paragraph [0017] of *Marks*, for example, assuming a value is transferred to the host location (*e.g.*, a discount rate, *etc.*), this paragraph describes that it is through the purchasing of merchandise that a consumer achieves a benefit, and thus any value delivered to the host would likely include ***an amount*** that the sender offers to credit a receiver for purchasing product corresponding to the ad, not ***a value that the sender is willing to pay to render the content message***.

Additionally, nothing in *Marks* discloses, teaches, or suggests a ***content packet*** that includes ***finishing instructions detailing how the content message is to be rendered***. *Marks* is less concerned with the rendering of the ad and more concerned with the fact that it is seen and that an immediate benefit accrues to the customer in the form of a rebate, coupon, or the like.

Because independent claim 13 is allowable over *Marks*, dependent claims 14-21 are allowable as a matter of law. Further, Applicants respectfully traverse the finding of Official

Notice as to claims 14-21. For example, nothing in *Marks* discloses, teaches, or suggests *a rules module is further configured to identify a first amount required for playing/displaying and audio/visual content message and a second amount required for printing a printable content message*, as recited in claim 14. Also, immediate gratification can be achieved through discounts or rebates of purchased products, as disclosed in *Marks*, and does not necessarily follow through the mechanisms described in claims 14-21. The emphasized claim features don't implicitly follow from the teachings of *Marks* in light of the knowledge of those having ordinary skill in the art and no evidence has been proffered to support the assertion of Official Notice. Thus, Applicants respectfully request that the rejection to claims 13-21 and the Official Notice be withdrawn.

Independent Claim 22

As recited independent claim 22, Applicants claim (with emphasis added):

22. A printer, comprising:
- an e-mail module configured to receive an e-mail message from one or more senders, said e-mail message containing a content packet that includes a content message that is printable on the printer and a print value that identifies a value the sender is willing to pay to print the content message;*
 - a rules module that contains a value required to print the content message and that is configured to print the content message if the print value is greater than or equal to the value in the rules module;
 - a print confirmation module configured to verify that the content message was printed;* and
 - a notice module configured to notify the sender that the content message was printed on the printer.

Applicants respectfully submit that *Marks* fails to disclose, teach, or suggest the emphasized features. The system in *Marks* discloses that ads are sent and received, but not in the form of a *content packet* with the structure described in independent claim 22. Further, *Marks* discloses a system that provides compensation "in the form of an immediate discount towards goods and/or services at the host merchant." (see Abstract) In such an operation, it does not necessarily flow that a *content packet* that includes *a print value that identifies a value the*

sender is willing to pay to print the content message is sent and received. From paragraph [0017] of *Marks*, for example, assuming a value is transferred to the host location (e.g., a discount rate, etc.), this paragraph describes that it is through the purchasing of merchandise that a consumer achieves a benefit, and thus any value delivered to the host would likely include *an amount* that the sender offers to credit a receiver for purchasing product corresponding to the ad, not *a print value that identifies a value the sender is willing to pay to print the content message*.

Additionally, nothing in *Marks* discloses, teaches, or suggests *a print confirmation module configured to verify that the content message was printed*. *Marks* is less concerned with the rendering of the ad and more concerned with the fact that it is seen and that an immediate benefit accrues to the customer in the form of a rebate, coupon, or the like.

Because independent claim 22 is allowable over *Marks*, dependent claims 23-29 are allowable as a matter of law. Further, Applicants respectfully traverse the finding of Official Notice as to claims 23-29. For example, nothing in *Marks* discloses, teaches, or suggests the content packet further comprises *a sender bank account identifier, the printer further comprising a funds verifier configured to verify that sufficient funds are in the sender bank account to pay the print value*, as recited in claim 24. That is, it is acknowledged in the Office Action that this claimed feature is not shown in *Marks*. And, as explained above, immediate gratification can be achieved through discounts or rebates of purchased products, as disclosed in *Marks*, and not necessarily through the mechanisms described in claims 23-29. The emphasized claim features don't implicitly follow from the teachings of *Marks* in light of the knowledge of those having ordinary skill in the art and no evidence has been proffered to support the assertion of Official Notice. Thus, Applicants respectfully request that the rejection to claims 22-29 and the Official Notice be withdrawn.

Independent Claim 30

As recited independent claim 30, Applicants claim (with emphasis added):

30. A method for distributing content messages to one or more receivers, comprising:

assembling a content packet at a computer device, the content packet including a content message and a rendering value;

sending the content packet to one or more receivers;

receiving notice that a receiver has rendered a content message from the content packet;

crediting the receiver that rendered the content message with an amount equal to the rendering value.

Applicants respectfully submit that *Marks* fails to disclose, teach, or suggest the emphasized features. The system in *Marks* discloses that ads are sent and received, but not in a format *including a content message and a rendering value*, as recited in independent claim 30. Further, *Marks* discloses a system that provides compensation “in the form of an immediate discount towards goods and/or services at the host merchant.” (see Abstract) In such an operation, it does not necessarily flow that a *content packet* that includes *a content message and a rendering value* is sent and received. From paragraph [0017] of *Marks*, for example, assuming a value is transferred to the host location (*e.g.*, a discount rate, *etc.*), this paragraph describes that it is through the purchasing of merchandise that a consumer achieves a benefit, and thus any value delivered to the host would likely include *an amount* that the sender offers to credit a receiver for purchasing product corresponding to the ad, not *a rendering value*.

Because independent claim 30 is allowable over *Marks*, dependent claims 31-39 are allowable as a matter of law. Further, Applicants respectfully traverse the finding of Official Notice as to claims 31-39. For example, nothing in *Marks* discloses, teaches, or suggests the *content packet* further comprises *a sender bank account identifier that may be used by a receiver to access a corresponding sender bank account to verify that the account exists*

and that there are sufficient funds in the account to cover the rendering value, as recited in claim 36. That is, it is acknowledged in the Office Action that this claimed feature is not shown in *Marks*. And, as explained above, immediate gratification can be achieved through discounts or rebates of purchased products, as disclosed in *Marks*, and not necessarily through the mechanisms described in claims 31-39. The emphasized claim features don't implicitly follow from the teachings of *Marks* in light of the knowledge of those having ordinary skill in the art and no evidence has been proffered to support the assertion of Official Notice. Thus, Applicants respectfully request that the rejection to claims 30-39 and the Official Notice be withdrawn.

Independent Claim 40

As recited independent claim 40, Applicants claim (with emphasis added):

40. A method for receiving content messages from one or more sender computer devices, comprising:

receiving a content packet from a sender computer device, the content packet containing a content message and a rendering value, the rendering value indicating an amount the sender computer device offers to credit for rendering the content message;

initiating rendering of the content message if the rendering value is greater than or equal to a pre-determined rendering limit;

notifying the sender computer device that the content message has been rendered; and

sending credit instructions to the sender computer device to receive credit for the rendering value.

Applicants respectfully submit that *Marks* fails to disclose, teach, or suggest the emphasized features. The system in *Marks* discloses that ads are sent and received, but not in the form of a *content packet* with the structure described in independent claim 40. Further, *Marks* discloses a system that provides compensation "in the form of an immediate discount towards goods and/or services at the host merchant." (see Abstract) In such an operation, it does not necessarily flow that a *content packet* that includes *a content message and a rendering value, the rendering value indicating an amount the sender computer device offers to credit for*

rendering the content message is sent and received. From paragraph [0017] of *Marks*, for example, assuming a value is transferred to the host location (e.g., a discount rate, etc.), this paragraph describes that it is through the purchasing of merchandise that a consumer achieves a benefit, and thus any value delivered to the host would likely include *an amount* that the sender offers to credit a receiver for purchasing product corresponding to the ad, not a *rendering value indicating an amount the sender computer device offers to credit for rendering the content message*.

Additionally, nothing in *Marks* discloses, teaches, or suggests *initiating rendering of the content message if the rendering value is greater than or equal to a pre-determined rendering limit*. *Marks* is less concerned with the rendering of the ad and more concerned with the fact that it is seen and that an immediate benefit accrues to the customer in the form of a rebate, coupon, or the like.

Because independent claim 40 is allowable over *Marks*, dependent claims 41-48 are allowable as a matter of law. Further, Applicants respectfully traverse the finding of Official Notice as to claims 41-48. For example, nothing in *Marks* discloses, teaches, or suggests the content packet further comprises the *rendering value is a first rendering value that indicates an amount the sender computer device offers to credit for displaying the content message* and *the content packet further includes a second rendering value that indicates an amount the sender computer device offers to credit for printing the content message*, as recited in claim 42. And, as explained above, immediate gratification can be achieved through discounts or rebates of purchased products, as disclosed in *Marks*, and not necessarily through the mechanisms described in claims 41-48. The emphasized claim features don't implicitly follow from the teachings of *Marks* in light of the knowledge of those having ordinary skill in the art and no evidence has been proffered to support the assertion of Official Notice. Thus,

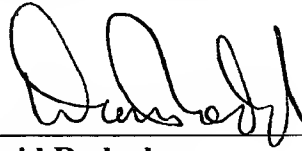
Applicants respectfully request that the rejection to claims 40-49 and the Official Notice be withdrawn.

Due to the shortcomings of the *Marks* reference described in the foregoing, Applicants respectfully assert that *Marks* does not anticipate or make obvious Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', is written over a horizontal line.

David Rodack
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